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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,018	07/27/2000	Helmut Weber	70442.1201	9975

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,018

Applicant(s)

WEBER ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wolf (G9421125.6). Wolf discloses a convertible rongeur comprising front handle piece 1.2, bottom shaft piece 2, 1.1 having shaft portion 2 and handle portion 1.1, top shaft cutting piece 5 slideably engaged along said longitudinal axis with the shaft portion 2, the top shaft cutting piece 5 being disengageable with the shaft portion 2 such that the top shaft cutting piece no longer touches the bottom shaft piece (when the top shaft cutting piece 5 is pivoted to the position shown in dashed lines in figure 1) but remains linked to the remainder of the rongeur (since it is still linked to movable jaw part 3.2 as indicated on page 5, lines 1-2 of the translation). Alternatively, it would have been obvious that the top shaft piece 5 is a "cutting" piece as claimed since it, in combination with the movable jaw part 3.2, performs the cutting action.

Claims 1-7 are allowed.

Applicant's arguments filed Dec. 29, 2005 have been fully considered but they are not persuasive. The top cutting piece 5 of Wolf is linked to the remainder of the rongeur when it is in the position shown in dashed lines in figure 1 for the following reasons: The top cutting piece 5 of Wolf is linked to the remainder of the rongeur when it is in the position shown in

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figure 2 since the forked end of the top cutting piece 5 is engaged to the pin 3.5 on jaw 3.2 and movement of the top cutting piece 5 along its longitudinal axis in either direction produces movement of the jaw 3.2 to open or close it. When top cutting piece 5 is in the position shown in dashed lines in figure 1, the forked end of the top cutting piece 5 is still engaged to the pin 3.5 on jaw 3.2 and movement of the top cutting piece 5 along its longitudinal axis in either direction (by for example, manually gripping the proximal end of top cutting piece 5 and manually moving it) would still produce movement of the jaw 3.2 to open or close it. In fact, it appears that the top cutting piece 5 is not even capable of being detached from the pin 3.5 until the top cutting piece 5 is pivoted to the position shown in solid lines in figure 1 due to the angled orientation of the forked end relative to the longitudinal axis of the top cutting piece 5. That is, the bottom fork of the forked end is trapped between the pin 3.5 and top surface of fixed jaw 3.1 until the top cutting piece 5 is pivoted to the position shown in solid lines in figure 1. Note that the top cutting piece 5 is required to be oriented in the position shown in solid lines in figure 1 in order to assemble it to the remainder of the device as indicated on page 6, lines 14-16 of the translation. Thus, the top cutting piece 5 remains

linked to the remainder of the rongeur (as claimed) when it is in the position shown in dashed lines in figure 1 and remains so until it is detached from the remainder of the rongeur after being pivoted to the position shown in solid lines in figure 1. The allegation that the Wolf instrument is not a cutting instrument is unfounded since it is clearly a cutting instrument when the forceps jaw is modified for cutting as indicated on page 7, lines 4-7 of the translation.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

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Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
4/20/06



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731